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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|----------------------|------------------|
| 10/797,870 | 03/10/2004 | Rieko Takahashi | KON-1858 | 3710 |
| 20311 | 7590 | 06/09/2005 | EXAMINER | |
| MUSERLIAN, LUCAS AND MERCANTI, LLP 475 PARK AVENUE SOUTH 15TH FLOOR NEW YORK, NY 10016 | | | GILLIAM, BARBARA LEE | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1752 | |

DATE MAILED: 06/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/797,870

Applicant(s)

TAKAHASHI ET AL.

Examiner

Barbara L. Gilliam

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>9/16/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims

1. Claims 1-20 are present.

Double Patenting

2. Claims 1, 7 and 9 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 6, 8-12 of copending Application No. 10/943,935 (US 2005/0064339 A1). Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to make a planographic printing plate material comprising a plastic film sheet support such as polyethylene terephthalate or polyethylene naphthalate and provided thereon, a hydrophilic layer and an image formation layer wherein the hydrophilic layer contains metal oxide particles such as colloidal silica and a light to heat conversion material and the image formation layer contains heat-melting particles or heat fusible particles based on the claims of Miyoshi. Miyoshi does not claim the $La \cdot b^*$ value, the transmission density of the hydrophilic layer or the glossiness of the image formation layer however the planographic printing plate material claimed by Miyoshi is expected to have properties consistent with the properties of the present application because the material of Miyoshi has components identical to the components of the present application. MPEP 2112.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Inoue et al. (EP 1 145 848 A2).

a. The lithographic printing plate precursor of Inoue et al. anticipates the presently claimed printing plate material. Specifically Inoue et al. teach a lithographic printing plate material comprising a hydrophilic support having thereon a heat-sensitive layer containing at least one of a thermoplastic particulate polymer, a particulate polymer having a heat-reactive group and a microcapsule containing a compound having a heat-reactive group incorporated therein (abstract; [0014]-[0062]). The support is dimensionally stable and can be made of various materials including paper, plastic and aluminum ([0108]-[0110]; [0155]). The support may be coated with a hydrophilic layer made of particulate silica and a hydrophilic resin ([0158]-[0164]). An interlayer can further be provided ([0147]; [0172]). A light to heat converting agent can be present in the heat-sensitive layer or layers adjacent thereto ([0088]-[0107]). The lithographic printing plate precursor is exposed to laser beam at a high output,

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preferably a laser which emits light in the infrared or near infrared, mounted untreated on the cylinder of a printing machine and subject to fountain solution and ink ([0173]-[0176]). Inoue et al. do not teach the $La \cdot b^*$ value, the transmission density of the hydrophilic layer or the glossiness of the image formation layer however the planographic printing plate precursor taught by Inoue et al. is expected to have properties consistent with the properties of the present application because the precursor of Inoue et al. has components identical to the components of the present application. MPEP 2112.

5. Claims 1-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Mori (US 2004/0154490 A1).

a. The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

b. The planographic printing plate material of Mori comprises a support such as a plastic support, an image formation layer containing hydrophobic precursor particles such as thermoplastic particles, heat melting particles, heat fusible particles and microcapsules (abstract; [0035]-[0058]; [0146]-[0150]) and a water soluble material such as an oligosaccharide ([0094]-[0100]). The image formation layer or an adjacent layer contains a light-to-heat conversion material ([0074]-[0090]). The

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planographic printing plate material may comprise another layer such as a hydrophilic layer or an under layer ([0091]; [0142]-0145]). A hydrophilic layer comprising metal oxide particles is specifically taught ([0101]-[0141]). The printing plate material is imagewise exposed and developed with dampening water and/or printing ink to obtain a printing plate (abstract; claims). Mori does not teach the La^*b^* value, the transmission density of the hydrophilic layer or the glossiness of the image formation layer however the planographic printing plate precursor taught by Mori is expected to have properties consistent with the properties of the present application because the precursor of Mori has components identical to the components of the present application. MPEP 2112.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. In US 6,110,644, Vermeersch et al. teach a method for making a lithographic printing plate involving on press development.

b. In JP 2001-334766 and US 6,688,228 B2, a planographic printing plate precursor is taught.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara L. Gilliam whose telephone number is 571-272-1330. The examiner can normally be reached on Monday through Thursday, 8:00 AM - 5:30 PM.

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a. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

b. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Barbara L. Gilliam

Barbara L. Gilliam
Primary Examiner
Art Unit 1752

bg
May 25, 2005